R E M A R K S

Prior to entry of this Amendment:

- Claims **1-29 and 72-91** were pending in the present application
- Claims **1-12, 14-29, 72, 80, and 86** stand rejected
- Claims **13, 73-79, 81-85, and 87-91** are objected to

Upon entry of this Amendment:

- Claims **1-29 and 72-91** will be pending
- Claims **1 and 21** will be the only independent claims

Telephone Interview

Applicants would like to thank the Examiner for the helpful telephone conversation held on October 22, 2003, with Applicants' representative. The Examiner and Applicants' representative discussed the present application in light of the French and Bonifas references.

Applicants' representative suggested that the French and Bonifas references, either alone or in combination, do not teach or suggest a feature generally directed to *associating a second non-zero value with a gaming token, the second non-zero value being different from a first non-zero value associated with the gaming token.*

Applicants' representative also suggested that Bonifas teaches away from changing the value associated with a gaming token.

While no formal agreement was reached, Applicants are grateful for the opportunity to discuss the present application with the Examiner.

Claims 13, 73-79, 81-85, 87-91 Contain Allowable Subject Matter

Applicants are grateful for the Examiner's acknowledgement that Claims **13, 73-79, 81-85, and 87-91** contain allowable subject matter. The Examiner objects to Claims **13, 73-79, 81-85, and 87-91** as being based upon rejected claims. Applicants believe that the arguments provided herein with respect to the rejected claims will overcome the Examiner's objection to Claims **13, 73-79, 81-85, and 87-91**.

Section 103(a) Rejection

Claims **1-5, 7-12, 14-16, 18-29, 72, 80, and 86** stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,735, 742 issued to French ("French") in view of U.S. Patent No. 6,050,487 issued to Bonifas, et al. ("Bonifas").

Claim **6** stands rejected under 35 U.S.C. 103(a) as being unpatentable over French in view of Bonifas and further in view of an unsupported assertion. [Office Action, pages 3-4].

Claim **17** stand rejected under 35 U.S.C. 103(a) as being unpatentable over French in view of Bonifas and further in view of U.S. Patent No. 5,361,885 issued to Modler ("Modler").

Applicants respectfully traverse all of the Examiner's Section 103(a) rejections.

1. No teaching or suggestion of all the features of independent Claims 1 and 21

Neither French, Modler nor Bonifas, alone or in combination, suggests changing the value associated with a gaming token or any benefit of affecting the value of a gaming token, much less when a value of a gaming token should be changed. Applicants respectfully submit that the French, Bonifas and Modler references, either alone or in combination, do not teach or suggest features generally directed to:

in response to detection of the event, associating a second non-zero value with the gaming token, the second non-zero value being different from the first non-zero value

as recited in independent Claim **1**; or

means, responsive to said detecting means, for associating a second non-zero value with said one of the gaming tokens, the second non-zero value being different from the first non-zero value

as recited in independent Claim **21**.

1.1. The cited references do not suggest changing the value of *a gaming token*

1.1.1. French: Value is "read-only"

Applicants agree with the Examiner's statement that French "fails to disclose a gaming chip/token wherein the value can be changed in response to event detection." [Office Action, pages 2-3]. French explicitly discloses that the value of a gaming chip is stored in "read-only format." [Column 4, lines 21-23].

1.1.2. Bonifas: "Chip card" is not a "token"

Contrary to the Examiner's assertion, Bonifas also does not suggest changing the value of a "gaming token/chip." [Office Action, page 3]. Applicants respectfully submit that the Examiner unfortunately has interpreted the "chip cards" of the Bonifas system as suggesting gaming tokens or gaming chips, and has also interpreted Bonifas as suggesting changing a value associated with a gaming token. The Examiner also asserts that Bonifas teaches a gaming chip

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including a memory. [Office Action, page 3]. Applicants respectfully traverse these interpretations.

The "chip cards" of <u>Bonifas</u> do not suggest gaming tokens, and in fact teach away from the use of gaming tokens at a gaming machine. The "chip cards" described in the <u>Bonifas</u> card-reader system are "well known" cards, "namely prepayment cards, used for example in telephone booths, and bank cards." [Column 3, lines 64-67]. Using the described cards with a card reader in the <u>Bonifas</u> system, "the player can once again play without having to recover tokens that would be redistributed <u>if the machine were working with tokens. It can be seen that it is possible to avoid loss of time as compared with the situation where tokens have to be obtained and put them back into the machine.</u>" [Column 5, lines 15-21].

In fact, in the <u>Bonifas</u> system, such cards are intended to provide "a more modern system…<u>replacing the use of tokens</u>" that are put into a game machine and/or released when a player wins (emphasis added). According to <u>Bonifas</u>, "the use of tokens is not practical. …Furthermore, the use of tokens slows down the use of the machine and limits the amount of money that can be wagered." [Column 1, lines 21-25, 34-40].

Thus, the "chip cards" described in <u>Bonifas</u> clearly do not teach or suggest gaming tokens. Only the "chip cards" of <u>Bonifas</u> are described as having changing values. Accordingly, there is no suggestion in <u>Bonifas</u> of changing the value associated with a gaming token.

<u>Modler</u> does not suggest changing the value of a gaming token—the Examiner does not assert otherwise.

1.2.   No motivation to combine

In fact, as <u>Bonifas</u> finds gaming tokens to be impractical, <u>Bonifas</u> teaches away from combination with <u>French</u> and teaches away from modifying gaming tokens in the manner proposed by the Examiner. As discussed above, <u>French</u> also does not suggest the desirability of changing the value associated with a gaming token, nor does <u>Modler</u>. Accordingly, there is no suggestion in the prior art of record of the desirability of modifying or combining the <u>French</u> and <u>Bonifas</u> systems to provide for the claimed features of associating a different non-zero value with a gaming token, as generally recited in each of independent Claims **1 and 21**.

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for independent Claims **1 and 21** (and claims **2-12, 14-20, 22-29, 72, 80, and 86** dependent therefrom).

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2. **No teaching or suggestion of all of the features of any of Claims 4, 6, 8, 10, 12, 27, 28, and 80**

Each of Claims **4, 6, 8, 10, 12, 27, 28, and 80** includes a feature generally directed to *associating a second (different) non-zero value with a gaming token in response to detection* of a particular event.

Unfortunately, in the discussion of each of Claims **4, 6, 8, 10, 12, 27, 28, and 80**, the Examiner merely asserts that the particular event alone is known. Thus, the Examiner ignores the limitation that beyond merely detecting the particular event, Claims **4, 6, 8, 10, 12, 27, 28, and 80** also provide for performing a step *in response to detection of the event*. Specifically, the Examiner does not present a reasoned finding that any of the cited references suggests either (i) changing the value of a gaming token in response to detection of any of the asserted types of events, or (ii) the desirability of such a feature. Thus, even if the detection of such events was known, which Applicants respectfully dispute, the Examiner has not provided evidence teaching or suggesting all of the features of any of Claims **4, 6, 8, 10, 12, 27, 28, and 80**.

As discussed above with respect to independent Claims **1 and 21**, there is no teaching or suggestion in either French, Modler, or Bonifas, alone or in combination, of associating a second non-zero value with a gaming token in response to the detection of any event. Accordingly, the cited references also cannot teach or suggestion such *associating in response to the detection of* any of:

> *insertion of the gaming token in a gaming device* (Claims **4 and 27**);
>
> *a period of time that a player has played a gaming device* (Claim **6**);
>
> *a number of times that a player has played a gaming device* (Claim **8**);
>
> *discharging of the gaming token from a gaming device* (Claims **10 and 28**); or
>
> *redeeming of the token* (Claim **80**); or
>
> *placing the gaming token in proximity to a value-changing device* (Claim **12**).

The Examiner does not assert that the cited references suggest associating a second non-zero value with a gaming token *in response to* the detection of any such events.

Bonifas teaches the insertion and removal of a "chip card" at a gaming machine. However, as discussed above, the "chip card" of Bonifas does not suggest changing the value of a gaming token, much less changing the value of a gaming token in response to detecting (i) the insertion (or removal) of a gaming token in (or from) a gaming machine; (ii) the redeeming of the gaming token; or (iii) placing the gaming token in proximity to a value-changing device. Accordingly, Applicants respectfully request that the Section 103 rejection of Claims **4, 10, 12, 27, 28, and 80** be withdrawn.

With respect to Claim **6**, the Examiner merely asserts that it would have been obvious to provide for associating a different value with a gaming token, *wherein the detected event is a period of time that a player has played a gaming device*. [Office Action, pages 3-4]. The Examiner does not indicate any support for this assertion in the evidence of record. Applicants therefore presume that the Examiner intended to take Official Notice of this subject matter. Given that the only particular information in the record thus far regarding what is considered to

be in the prior art is this Examiner's brief statement, Applicants cannot properly determine the bounds of the prior art. Accordingly, Applicants dispute (i) that the subject matter asserted was "well known" at the time the invention was made, and (ii) that it would have been obvious to modify <u>French</u> and <u>Bonifas</u> to provide for such a feature. Applicants also request a reference to clarify the subject matter in more detail. MPEP 2144.03.

With respect to Claim **8**, the Examiner does not assert any reference as teaching or suggesting associating a different value with a gaming token, *wherein the detected event is a number of times that a player has played a gaming device.* Applicants respectfully request that the Section 103 rejection of Claim **8** be withdrawn.

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for Claims **4, 6, 8, 10, 12, 27, 28, and 80** (and for Claims **5, 7, 9, and 11** dependent therefrom).

3. **Claim 17**

With respect to Claim **17**, Applicants have carefully reviewed <u>Modler</u>, including the passage cited by the Examiner, but have been unable to identify a teaching or suggestion in <u>Modler</u> of *a display device mounted on a gaming token*, as recited in Claim **17**. Applicants respectfully request that the Examiner clarify the rejection of Claim **17** in light of the cited references. Applicants respectfully submit that none of the cited references teaches or suggests *displaying at least one of the values of the gaming token via a display device mounted on a gaming token*, as recited in Claim **17**.

Also, <u>Modler</u> explicitly teaches away from the Examiner's proposed combination of <u>Bonifas</u>, <u>French</u> and <u>Modler</u>. Specifically, <u>Modler</u> teaches away from the use of electronic devices in a gaming chip: "[T]he implementation of...small computer chips in gaming chips is impractical because the computer chips are destroyed by the high temperatures used in forming typical plastic gaming chips." Column 1, lines 27-32. Thus there is no motivation to combine <u>French</u> and <u>Modler</u>.

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of Claim **17**.

Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to <u>Deposit Account No. 50-0271</u>. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to <u>Deposit Account No. 50-0271</u>.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

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Date

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